

**REMARKS**

Claims 1, 3-16 and 18 are pending in this application. By this Amendment, claim 17 is canceled without prejudice to or disclaimer of the subject matter recited therein. Claims 1 and 3-16 are amended, and claim 18 is added. No new matter is added.

**I. Claim Rejections Under 35 U.S.C. §102**

Claims 1-4, 8 and 9 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,171,254 to Sher. As claim 2 is canceled the rejection of that claim is moot. The rejection of claims 1, 3, 8 and 9 is respectfully traversed.

Sher fails to disclose each and every feature recited in the rejected claims, as amended. For example, Sher fails to disclose a holding apparatus for holding a vitreous body surgical contact lens on an eyeball, comprising an eyelid opener portion that pulls and opens an upper eyelid and a lower eyelid; a holding portion that holds the vitreous body surgical contact lens on an eyeball; and a connecting portion connected to the holding portion and the eyelid opener portion so that a position of the holding portion relative to the eyelid opener portion and the eyeball is adjustable, as recited in amended claim 1.

Furthermore, Sher fails to disclose a holding portion for holding a vitreous body surgical contact lens on an eyeball, connected to an eyelid opener portion that pulls and opens an upper eyelid and a lower eyelid through a connecting portion, so that a position of the holding portion relative to the eyelid opener portion and the eyeball is adjustable and the vitreous body surgical contact lens is held on the eyeball, as recited in amended claim 9.

Sher discloses an eye fixation device useful in restraining movement of an eye during ophthalmic procedures (col. 1, lines 5-7). The eye fixation device includes a speculum 20 and a fixation ring 60 (see Fig. 2). The speculum 20 includes a pair of parallel tubes 28 connected by telescoping tubes 30, 32 which have a spring 34 disposed therein to bias the parallel tubes 28 outwardly from one another. The speculum has a pair of blades 22 at the

end of each parallel tube 28 for holding open the eyelids of a patient. The fixation ring 60 includes a pair of attachment plates 66 which engage the blades 22 through a series of vacuum holes 24 on the blades 22. Thus, when a vacuum force is applied, the fixation ring 60 is held stably in place on the speculum 20 fixing the eye (Fig. 1; col. 2, line 45 - col. 3, line 33). Thus, Sher does not disclose a connecting portion for connecting the holding portion to the eyelid opener portions, so that a position of the holding portion relative to the eyelid opener portions on the eyeball is adjustable.

The Office Action alleges that because the annular portion of the fixation ring and the blades are separable from one another that they are adjustable. However, even were the term adjustable subject to the expansive definition given in the Office Action, Sher does not disclose that a position of the annular portion of the fixation ring, i.e., the alleged holding portion, is adjustable relative to the eyelid opener portion 22 and the eyeball. Rather, the alleged connection portions 24 merely hold the fixation ring 60 in one stable or fixed position. When the vacuum force is applied through the vacuum holes 24, the fixation ring 60 is securely held to the speculum 20. When the vacuum is not applied to the vacuum holes 24, the fixation ring may be removed. Thus, attaching or removing a fixation ring relative to the speculum cannot be considered as adjustable as the term is used in this application or in common parlance.

Furthermore, the vacuum holes 24 of Sher, do not hold a vitreal body surgical contact lens on the eyeball. Rather, the vacuum holes merely hold the fixation ring 60 on the speculum 20. The Office Action alleges that the phraseology of "for holding the vitreal body ..." recites only functional language or intended use, and that if Sher is capable of performing these functions, it meets the limitations of the claims. As Sher does not disclose such a capability, and the Office Action fails to provide evidence of such functionality, imputing the functionality to the vacuum holes 24, indicated in the Office Action as

corresponding to the holding portion, is not proper without further support. Also, as such functional language is removed in the rejected claims, the point is moot.

Finally, Sher merely relates to an apparatus for securing the eyeball of a patient to the bony orbital eye socket to prevent corneal deformation during a surgical procedure. Sher achieves the securing of the eyeball by attaching the fixation ring 60 to the speculum so as to strongly secure the position of the eyeball by the fixation ring. Thus, even were the device of Sher used with the vitreous surgical contact lens, the position would be similarly strongly secured and therefore not adjustable. Accordingly, withdrawal of the rejection of claims 1-4, 8 and 9 is respectfully requested.

Claims 1, 2, 4, 5 and 10 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,556,417 to Sher (the '417 patent). As claim 2 is canceled, the rejection of that claim is moot. The rejection of claims 1, 4, 5 and 10 is respectfully traversed.

The '417 patent similarly discloses a speculum 20 having a pair of opposed retractors 22 for holding a patient's eyelids open against the bony orbit of the eye socket. The '417 patent also discloses a fixation ring 61 which is to be positioned concentrically about the cornea of an eye (col. 2, lines 64-66). Thus, like the Sher reference, the '417 patent merely provides a device for fixating the eyeball of a patient during an ophthalmic procedure (col. 1, lines 61 and 62). Therefore, the '417 patent fails to disclose a holding portion for holding the vitreous body surgical contact lens on an eyeball, or a connecting portion connected to the holding portion and the eyelid portion so that a position of the holding portion relative to the eyelid opener portion and the eyeball is adjustable. Although the Office Action alleges that the fixation ring 61 is capable of holding a vitreous body surgical contact lens on an eyeball, there is no such disclosure in the reference, nor does the Office Action provide any support for the conclusory statement. Accordingly, withdrawal of the rejection of claims 1, 2, 4, 5 and 10 under 35 U.S.C. §102(b) is respectfully requested.

**II. Claim Rejections Under 35 U.S.C. §103**

Claims 6, 7 and 12-15 are rejected under 35 U.S.C. §103(a) as unpatentable over Sher. The rejection is respectfully traversed.

It is admitted in the Office Action that Sher fails to disclose a holding apparatus for the vitreous body surgical contact lens having a connecting portion of silicone rubber, as recited in claim 7. However, it is alleged in the Office Action that col. 7, lines 13-27 of Sher teach that any type of alternative equivalent mechanical attachment mechanism could be used to secure the ring 61 to the eyelid openers 22. However, Sher does not contain a column 7. Applicant believes the Office Action may be referring to col. 3, lines 21-23 which recite that mechanical attachment mechanisms could be used to attach the fixation ring 66 to the speculum 20.

Sher discloses that such mechanical attachment mechanisms could include a hook and loop adjustment, or even pressure sensitive or quick setting adhesives. However, none of these alternative means of connecting the fixation ring to the blades renders obvious a connection portion for connecting the holding portion to the eyelid opener portions so that a position of the holding portion relative to the eyelid opener portions and the eyeball is adjustable. Rather, Sher specifically refers to nonadjustable means of attachment, such as adhesives.

Regarding claim 12, as discussed above in reference to the rejection of claim 1 in light of Sher, the reference fails to disclose a connecting portion that is adjustable, as recited in the amended claim. Accordingly, withdrawal of the rejection of claims 6, 7 and 12-15 under 35 U.S.C. §103(a) is respectfully requested.

Regarding the rejection of claim 13, Sher fails to disclose a closed loop member for connecting the holding portion for the vitreous body surgical contact lens having elasticity

and being capable of connecting the holding portion for the vitreous body surgical contact lens in a semi-fixed state with friction, as recited in the amended claim.

The Office Action alleges that it would have been an obvious matter of design choice to replace the attachment plate 66 and the trusses 68 of the fixation ring 60 with a "simple loop of rubber".

Even were the attachment plates 66 and trusses 68 of Sher replaced with a simple loop of rubber, the loop of rubber would not connect the holding portion of a vitreous body surgical contact lens in a semi-fixed state with friction, nor would such a closed loop member allow for the adjustment, as recited in the claims. Replacing the attachment plate and trusses with a loop of rubber would also certainly interfere with the blades of the speculum and most likely not allow the eyeball to be securely fixed in position, thereby rendering the invention useless for its intended purpose.

Claim 11 is rejected under 35 U.S.C. §103(a) as unpatentable over Sher in view of U.S. Patent 3,139,298 to Grabiell. The rejection of claim 11 is respectfully traversed.

Claim 11 is allowable for its dependency on independent claim 9 for the reasons discussed above, as well as for the additional features recited therein. Accordingly, withdrawal of the rejection of claim 11 under 35 U.S.C. §103(a) is respectfully requested.

### **III. New Claim**

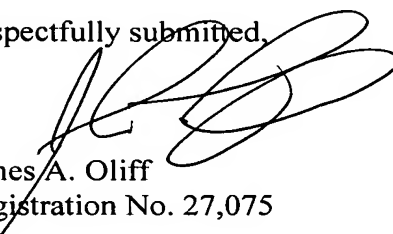
None of the applied references, whether considered alone or in combination, disclose or suggest each and every feature recited in claim 18. For example, the combination of references fails to disclose or suggest the connecting portion according to claim 13, wherein the closed loop member is a rubber member having a ring shape.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-16 and 18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

John W. Fitzpatrick  
Registration No. 41,018

JAO:JWF/ldg

Date: August 12, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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